

**REMARKS**

Claims 5-9 stand objected to as being improper multiple dependents. It is respectfully submitted that the enclosed amendment obviates this issue. Accordingly, it is respectfully requested that this objection be withdrawn.

Claims 1-3 (claim 4 appears to be inadvertently included in the 102 rejection in view of the 103 rejection against claim 4) stand rejected under 35 U.S.C. § 102 as being anticipated by Corts et al. '228 ("Corts"), and claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Corts. These rejections are respectfully traversed for the following reasons.

Claim 1 recites in pertinent part, "wherein the control means controls the audio output means so as to reproduce each additional audio clip *when the corresponding manually operable function is operated manually by the user.*" The Examiner admits that Corts does not disclose or suggest storing "respective audio clips relating to the manually operable functions of the receiver" and apparently concludes that such a feature would have been obvious. It is respectfully submitted that the Examiner's allegation is *per se* improper because the Examiner has not provided any prior art which discloses the claimed feature as required under § 103.

Indeed, according to one aspect of the present invention, the claimed combination can provide a receiver which is easy to operate by visually impaired users by enabling operational guidance. In contrast, a conventional receiver as in Corts is not ideal for a visually impaired user because many of the controls may be confusingly similar to the touch and the displays are often relatively small LCD displays which are sometimes difficult to read in certain light conditions. For example, while a visually impaired user can often remember the location and function of the controls, there are situations where the same physical controls can have their actual function

altered by a menu system and the altered functions are displayed on the display. In these circumstances, it is relatively easy for a visually impaired user to become confused.

Turning back to the present invention, according to the claimed combination, when a user operates one of the controls to achieve a desired function the system can then cause the desired function to occur *and in addition can cause the appropriate audio clip to be selected and played to the user*. In this way, the user can obtain audio confirmation of his/her selection without needing to view a small control panel/display, etc.. Corts is completely silent as to such problems, let alone suggest how to obviate such problems in the specific manner by which the present invention can do so in terms of the relationship between the audio clips and manual operation. Corts therefore provides absolutely no motivation whatsoever for the proposed modification.

The Examiner merely discounts the claimed features admittedly not disclosed by Corts as allegedly being obvious without support whatsoever from any of the cited prior art. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, *all* the claim limitations must be taught or suggested *by the prior art*. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the cited prior art fails the "all the claim limitations" standard required under § 103. The Examiner has failed to identify any portions of the cited prior art which allegedly suggest the claimed structure. What the *Examiner* believes to be obvious is irrelevant in determining patentability under § 103.

In this regard, it is respectfully submitted that the Examiner has merely concluded that the claimed invention would have been obvious based on the Examiner's own *opinion*, which is not commensurate with the requirements under § 103. Accordingly, absent any prior art teachings of the specific features recited in the claims, the pending rejection is necessarily based solely on improper hindsight reasoning using only Applicants' specification as a guide to reconstruct the claimed invention. The "Examiner's opinion" can not be relied on to replace the deficiency of a prior art reference.

If the Examiner intended to take Official Notice that the differences between the present invention and cited prior art and/or the motivation to modify Corts are well-known in the art, then pursuant to MPEP § 2144.03, Applicants respectfully traverse such an assertion and request the Examiner to cite a reference in support of his position (*see* second paragraph, last three lines of MPEP § 2144.03, which requires the Examiner to cite a reference in support of his allegation of Official Notice when Applicants traverse). Indeed, only Applicants' specification discloses the claimed features, and supplies the motivation for providing them within the particular combination recited in claim 1 (e.g., improvement for visually impaired users, personalization, etc.).

At best, the Examiner's basis for the rejection amounts to nothing more than a general allegation that one of ordinary skill in the art *can* achieve the claimed invention, which is not a proper standard by which to make a rejection under § 103. The Examiner is directed to MPEP § 2143.03 under the subsection entitled "Fact that References Can Be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness", which sets forth the proper standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

In the instant case, even assuming *arguendo* that Corts can be modified to reach the claimed invention, it is submitted that the "mere fact that [Corts] can be modified ... does not render the resultant modification obvious" because nowhere does the *prior art* "suggest the desirability of the modification" as set forth by the Examiner.

In this regard, it is respectfully submitted that the Examiner's allegation that "it would have been ... well within the level of a person of ordinary skill in the art to transmit audio relating to the manually operable functions of the receiver in order to help user(s) to be familiar with the operational functions of the receiver" is an improper basis for making a rejection under § 103. Indeed, such an allegation is completely irrelevant to patentability determination. In the first place, the Examiner's motivational reliance "to help user(s) to be familiar with the operational functions of the receiver" is derived solely from Applicants' specification and is therefore an exercise of improper hindsight reasoning.

The Examiner is directed to MPEP § 2143.01 under the subsection entitled "Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

A statement that modifications of the prior art to meet the claimed invention would have been [obvious] because the references relied upon teach that all aspects of the claimed invention were *individually* known in the art is *not* sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

As admitted by the Examiner, the cited prior art does NOT even teach that all aspects of the claimed invention are known in the art, and even if the prior art did so, the prior art would nonetheless still have to provide the objective evidence to make a combination thereof. In the instant case, there is no *objective* evidence derived from prior art which supports the Examiner's modification. Only Applicants' specification provides the requisite motivation (e.g.,

improvement for visually impaired users, personalization, etc.) for achieving the claimed combination..

Moreover, even assuming *arguendo* that the cited prior art did "teach that all aspects of the claimed invention [are] individually known in the art", it is submitted that such a conclusion "is not sufficient to establish a *prima facie* case of obviousness" because there is no *objective* reason on the record to combine such teachings of the cited prior art.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

### **CONCLUSION**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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